REMARKS

This is a full and timely response to the outstanding final Office Action mailed July 26, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I.   Claim Rejections - 35 U.S.C. § 103(a)

A.   Rejection of Claims 1-3, 5, and 7-13

Claims 1-3, 5, and 7-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy, et al. ("Kennedy", U.S. Pat. No. 6,651,217) in view of Goheen (U.S. Pat. No. 5,724,520) further in view of Berger, et al. ("Berger", U.S. Pat. No. 6,112,986). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, there is no suggestion or motivation in the prior art to modify the Kennedy reference in the manner suggested in the Office Action, and the references do not teach or suggest all the claim limitations. In the following, Applicant discusses the applied references and their relevance to Applicant's claims.

A.   The Kennedy Reference

Kennedy discloses a system with which forms can be automatically completed. When a user first populates a form presented to the user with a web site, the information provided by the user is extracted and used to create a profile for the user that can be used to automatically complete subsequently-displayed forms that are encountered at other web sites. Kennedy, Abstract; column 6, lines 19-23.

B.   The Goheen Reference

Goheen discloses a system for issuing electronic authorization and validation for scheduled activities, such as airline reservations. Goheen, Abstract. As is described by Goheen, when an airline passenger makes a reservation, the passenger is issued an identification card that stores passenger information. Goheen, column 2, lines 51-54. When the passenger arrives at the airport terminal, the passenger swipes the card at an ATM. Goheen, column 2, lines 61-66. Upon reading the passenger information stored on the card, the ATM displays various information to the user, such as the gate and time of departure. Goheen, column 3, lines 4-7. In addition, the ATM prints out a "print-out

tape" that comprises the same information. <u>Goheen</u>, column 3, lines 9-11; column 7, lines 40-44. The passenger then proceeds to his or her gate.

Once arriving at the gate, the passenger provides the identification card to a flight attendant, who swipes the card through a magnetic card reader to confirm that the passenger has a reservation and is authorized to board the aircraft. <u>Goheen</u>, column 3, lines 20-25. Goheen says nothing whatsoever about filling out forms.

C.   The Berger Reference

Berger discloses a system for putting user information on a credit card-like medium that can be scanned at an office or hospital. <u>Berger</u>, Abstract.

D.   Applicant's Claims

Applicant claims methods and systems for completing forms. For example, independent claim 1 provides as follows (emphasis added):

> 1.   A method for completing forms, comprising:
> reading a user data card *to determine a network location at which user information to be added to a form is stored*;
> *retrieving the user information from the network location*;
> configuring the user information for merging with the form;
> merging the user information into the form by populating form data fields with pieces of the user information; and
> *printing a hard copy form that contains at least a portion of the user information*.

As is described in the following, the proffered rejection fails to render Applicant's claims obvious for several reasons.

1. Lack of Motivation to Combine/Modify

As is described above, Kennedy discloses a system for automatically completing forms. It is there, however, where the similarities between Kennedy's system and Applicant's claimed methods and systems end. Specifically, Kennedy fails to teach or suggest any of "reading a user data card to determine a network location at which user information to be added to a form is stored", "retrieving the user information from the network location", or "printing a hard copy form that contains at least a portion of the user information".

To account for these shortcomings of the Kennedy reference, the Office Action relies upon the teachings of Goheen. As an initial matter, the propriety of combining the Goheen and Kennedy references is questionable since, as is stated above, Kennedy teaches a system for automatically completing forms on web sites, while Goheen teaches a system, used in airports, for enabling airline passengers to more quickly and easily board their aircraft. Again, the motivation or suggestion to combine references or modify an invention of one reference in view of one from another reference must be found *in the prior art*. <u>In this case, there is simply no motivation in the prior art for combining the Kennedy and Goheen references or modifying Kennedy's web site form-completion system in view of Goheen's airplane-boarding system</u>. Given the lack of a suggestion or motivation contained in the prior art for the proposed modification, it is clear that the only suggestion or motivation comes from Applicant's own disclosure. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

Aside from the lack of motivation in the prior art, the combination of Kennedy and Goheen is troubling because of the distinct problems that are being solved by their systems. Again, Kennedy describes populating forms on web sites in order to place online orders, while Goheen describes facilitating airline check in and aircraft boarding. There is simply no reason why a person having ordinary skill in the art would think to incorporate Goheen's processes into Kennedy's system. This is particularly true given that Goheen's processes are used to confirm a user's authorization to do something, and not to provide any information in a form. Given the disparate purposes of the two systems, combination is just not warranted.

With specific regard to the limitations of Applicant's claims, a person having ordinary skill in the art would not be motivated from the disclosures of Kennedy or Goheen to combine their teachings and incorporate "reading a user data card to determine a network location at which user information to be added to a form is stored" into the Kennedy system. As is described in the foregoing, the Kennedy system is solely used in the Internet environment. In particular, a user's information is extracted from a form that a user completes on a first web site, and that information is used to fill in another form on another web site.

Given the environment in which Kennedy's system operates, it is unclear why a person having ordinary skill in the art would be motivated to add a card reader, such as that of Goheen's airport ATM, to the Kennedy system. Specifically, because the user can, with Kennedy's system, simply enter information in an onscreen form while sitting at his or her computer, a person having ordinary skill in the art would not be motivated to add an identification card and card reader into the operation of Kennedy's system. In fact, such a person would be motivated away from such a modification because a card reader is totally unnecessary to Kennedy's system and

would add expense and complexity to the operation of that system. As is well established in the law, "[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . ." *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

Next, regarding the limitation "printing a hard copy form that contains at least a portion of the user information", the inferences drawn in the Office Action are similarly unwarranted. Again, Kennedy describes a system in which forms of web sites can be automatically populated, for example to complete an online purchase (see Kennedy, column 1, lines 20-23). Given that no hard copy of the form is required from the user (the user information is received through the web form), there is simply no reason to add the action of "printing a hard copy form that contains at least a portion of the user information" to Kennedy's described process. Indeed, the information that would be printed in such a case would not be information that the user would like to have a copy of (such as information about the order he or she has placed), but instead would be information that the user already knows, such as the user's name, address, and credit card information. It is for this reason that Kennedy is silent as to printing out a form: to print such a "form" would serve no purpose for the user.

In regard to the Berger reference, the Office Action presumably cites Berger to support the combination of the features of Goheen's system with the Kennedy system. Although the Berger reference concerns providing information, Berger's teachings do

not overcome the problems with combining the features of Goheen's system with Kennedy's system. Specifically, nothing in the Berger disclosure overcomes the fact that a person having ordinary skill in the art would not be motivated to add use of an identification card and card reader to Kennedy's system, or printing out information for a user of Kennedy's system. For at least these reasons, the rejection fails to make a *prima facie* case of Applicant's claim 1, or the claims the depend therefrom.

In the outstanding Office Action, the Examiner responds to Applicant's arguments regarding the lack of motivation to combine and modify. Specifically, the Examiner argues that it would have been obvious to add a card reader to the Kennedy system "in order to save time and prevent errors in filling out forms." Final Office Action, page 12, line 1. This argument lacks merit. First, the information on a data card must somehow be entered on the card before it can be used. Therefore, if the information is going to be used to fill in forms, the user must at some point enter information, for example in a shell form, for storage on the card. No time would be saved relative to Kennedy's method because, in Kennedy's system, the user provides the information at a web site. If anything, more time would be spent in entering the information and then downloading it to the card. As for having a card that contains the information, this would not benefit the user in Kennedy's system because, in Kennedy's system, the information is already directly accessible over the Internet. In other words, if the user needed the information to fill out an online form, the information is already immediately available through Internet communications, as described by Kennedy, and no convenience is provided to the user in having the information stored on a data card.

The Examiner further argues that Applicant's invention was "very well known in the art." Final Office Action, page 12, lines 10-11. Applicant respectfully asserts that the Examiner is analyzing Applicant's claim limitations in a piecemeal manner.

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Specifically, the issue as to whether various technologies, such as card reading, were known at the time of the invention does not determine whether Applicant's claimed inventions are obvious. What the Examiner must establish is that Applicant's claims, as a whole, would have been obvious. Therefore, at issue is not whether card readers are known, but whether it would have been obvious to add card reading to Kennedy's system. As is explained in detail above, there is no support in the prior art for such an argument. *See Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed").

2.   Lack of Teaching/Suggestion of All Claim Limitations

Aside from the lack of motivation to combine the references and modify the Kennedy system in the manner proposed by the Examiner, the rejection also fails to account for each of Applicant's claim limitations. For example, with further reference to claim 1, the references, even if properly combinable, still fail to teach or suggest reading a user data card "to determine a network location at which user information to be added to a form is stored". Specifically, although Goheen describes a passenger data card that stores passenger information, Goheen does not teach that the passenger data card identifies a "network location at which user information" is stored that is to be "added to a form". Neither the Kennedy reference nor the Berger reference provides this missing teaching.

For similar reasons, the references do not teach or suggest "retrieving the user information from the network location." Specifically, if the references do not teach reading a data card to determine a network location at which user information is stored,

it logically follows that the references further do not teach retrieving that information "from the network location."

3. Dependent Claims

Applicant's dependent claims contain further limitations that are not taught or suggested by the applied references. For example, regarding claims 2 and 10, the references do not teach or suggest that the data card is read by a "card reader of a printer" or "a card reader of a printing device". As to this limitation, Goheen's ATM is not a "printer" or a "printing device" within the plain meaning of those terms to a person having ordinary skill in the art.

Regarding claim 3, the references do not teach or suggest that read location information comprises a "universal resource locator (URL)". Although Kennedy mentions the use of URLs, modification of the Kennedy system in the manner suggested by the Examiner would result in all information being retrieved from the Goheen data card, *not* from another web site as in the unmodified Kennedy teaching.

Regarding claims 5 and 12, the references do not teach or suggest a network that comprises the Internet. Again, modification of the Kennedy system in the manner suggested by the Examiner would eliminate Kennedy's Internet-based retrieval of form information.

Regarding claims 7 and 8, the references do not teach or suggest "confirming authorization" by, for example, "receiving a passcode". Specifically, simply reading an ID number from a card in Goheen's system does not equate to "confirming authorization". For example, if someone stole the user's card, that person would be able to access the user's information in Goheen's system given that no authorization confirmation is practiced in Goheen's system.

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B.   Rejection of Claims 14, 15, and 17-20

Claims 14, 15, and 17-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over <u>Kennedy</u> in view of <u>Goheen</u> and <u>Berger</u>, further in view of <u>Lynch</u> (U.S. Pat. No. 5,852,977). Applicant respectfully traverses this rejection.

Independent claim 14 provides as follows (emphasis added):

> 14.   A *printing device*, comprising:
>
> printing hardware included within the printing device with which hard copy documents can be generated;
>
> a card reader provided on the printing device that *is adapted to read location information from a user data card*;
>
> a network interface device that is *adapted to retrieve user information from a network location identified in the location information*;
>
> printing device memory that stores forms; and
>
> *a form generation module stored in the printing device memory that merges the user information with a form stored in the device memory for the purpose of printing a hard copy form that is at least partially completed*.

As an initial matter, Applicant reiterates the comments provided above as to the lack of motivation to combine the applied references and to modify the Kennedy system in the manner proposed by the Examiner. Accordingly, those comments are incorporated herein in relation to claim 14 and the claims that depend therefrom.

With particular regard to independent claim 14, the Kennedy, the Goheen, and the Berger references do not concern a "printing device". <u>Contrary to that alleged in the Office Action, Kennedy does not mention a printing device that performs form generation.</u> Furthermore, nothing in the prior art suggests incorporating form

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generation of the manner described in claim 14 into a printing device. Regarding the Goheen reference, Goheen does mention that Goheen's terminal ATM can print a "print-out tape." Regardless, one having ordinary skill in the art would hardly consider Goheen's ATM to be a "printing device", particularly in view of the definition that is provided by the Applicant. Berger similarly fails to describe a printing device. Moreover, Lynch's "terminal" is also not a "printing device".

Turning to the individual limitations of claim 14, the references do not teach or suggest a card reader provided on the printing device that is "adapted to read location information from a user data card". Again, no "location information" is read from a data card in the Goheen system. Instead, the card simply identifies the user (passenger) to the system.

Furthermore, the references do not teach or suggest a network interface device that is "adapted to retrieve user information from a network location identified in the location information". Specifically, assuming the Kennedy system is modified in the manner suggested by the Examiner, user information is not retrieved from the network location but instead is merely read from Goheen's data card.

In addition, the references do not teach or suggest a printing device that includes printing device memory that "stores forms". Specifically, Goheen's "printing device" stores no forms.

Finally, the references do not teach or suggest a printing device that includes a "form generation module" that "merges the user information with a form stored in the device memory". Specifically, Goheen's "printing device" performs no merging of user information with any form.

Regarding the claims that depend from claim 14, the references do not teach or suggest a printing device comprising a "network browser" as in claim 17, or an
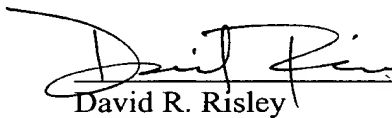
"Internet browser" as in claim 18. Specifically, contrary to that argued in the Office Action, Kennedy does not teach a printing device that further comprises those components. Column 2, line 28 of the Kennedy reference says *nothing* about a "printing device" having such components. Again, the Examiner cannot properly analyze the claims in a piecemeal manner.

Regarding claims 19 and 20, the references do not teach or suggest that the printing device of claim 14 is a "printer" or a "multifunction peripheral device (MFP)". Although Kennedy states the obvious that a computer may be connected to a printer, *nowhere* does Kennedy describe a printer or MFP that comprises the components and performs the tasks described in claim 14. All actions described in Kennedy disclosure are performed by a computer 100, not a printing device (see Kennedy Figure 1).

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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